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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,711	03/10/2004	Robert W. Driscoll	54317-029101	6173
46560 7590 01/12/2009 THE WALT DISNEY COMPANY C/O GREENBERG TRAURIG LLP 2450 COLORADO AVENUE SUITE 400E SANTA MONICA, CA 90404				
EXAMINER				
DUFFY, DAVID W				
ART UNIT		PAPER NUMBER		
3714				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/798,711

**Applicant(s)**

DRISCOLL ET AL.

**Examiner**

DAVID W. DUFFY

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-11 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11 and 19-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF008)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. This office action is in response to the amendment filed 11/12/2008 in which applicant amends claims 1, 6, 9 and 19; cancels claim 5; and adds claim 28. Claims 1-4, 6-11, and 19-28 are pending.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 28 recites the limitation "the persons" in the 14<sup>th</sup> line of the claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-4, 6-11 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabai et al. (US 6352478) in view of Rose; William J. (US 4857030 A).
7. In regards to claim 1, Gabai discloses a system that has a number of fanciful toy figures with wireless communication systems (48:30-37) where the toy figures include freely mobile characters and a portable owl doll for users to carry (49:6-15 and 49:19-

28) where the mobile character transmits information identifying the character (48:66-49:5) and information is received by the other figures (50:47-49). Gabai further discloses that the figures have the ability to direct users to facilities in the theme park (56:34-39 and 56:65-57:9) as well as to direct them to the location of other users in the park (53:27-54:14). Gabai lacks explicitly stating that the portable toy would be able to notify the user that a mobile character is nearby.

8. In related prior art, Rose discloses a device responsive to receipt of a signal transmitted by another to automatically notify the user via the device that a character is nearby (2:16-40). One skilled in the art would recognize the stated advantages of a doll with responsive speech to provide inspiration for a child's imagination and to maintain the child's interest in said doll (1:59-2:15). One of ordinary skill in the art would further recognize that any audio message could be used.

9. Therefore it would have been obvious to one skilled in the art at the time of the invention to have modified Gabai in view of Rose to have included a response to the signal of a nearby character in order to stimulate the child's imagination and maintain the child's interest in the doll.

10. In regards to claims 2 and 3, Gabai discloses the use of infrared or radio frequency signals (51:15-24).

11. In regards to claim 4, Gabai discloses that each figure or node has an ID (figure 43A, element 2850).

12. In regards to claim 6, Gabai discloses a system with a number of wireless signal transmitters at various locations throughout a theme park environment (48:66-49:5), that

has a number of fanciful toy figures with wireless communication systems (48:30-37) where the toy figures include freely mobile characters and a portable owl doll for users to carry (49:6-15 and 49:19-28) where the mobile character transmits information identifying the character (48:66-49:5) and information is received by the other figures (50:47-49). Gabai further discloses that the figures have the ability to direct users to facilities in the theme park (56:34-39 and 56:65-57:9) as well as to direct them to the location of other users in the park (53:27-54:14). Gabai lacks explicitly stating that the portable toy would be able to notify the user that a mobile character is nearby.

13. In related prior art, Rose discloses a device responsive to receipt of a signal transmitted by another to automatically notify the user via the device that a character is nearby (2:16-40). One skilled in the art would recognize the stated advantages of a doll with responsive speech to provide inspiration for a child's imagination and to maintain the child's interest in said doll (1:59-2:15). One of ordinary skill in the art would also recognize that any audio message may be used.

14. Therefore it would have been obvious to one skilled in the art at the time of the invention to have modified Gabai in view of Rose to have included a response to the signal of a nearby character in order to stimulate the child's imagination and maintain the child's interest in the doll.

15. In regards to claims 7 and 8, Gabai discloses the use of infrared or radio frequency signals (51:15-24).

16. In regards to claim 9, Gabai discloses a system that has a number of fanciful toy figures with wireless communication systems (48:30-37) and memory (figures 71 and

74, element 4030 and 4270 respectively, which are related to figure 6 with description 35:31-32), where the figures are able to receive signals and trigger playback of preprogrammed data related to received signals (instructs the child to stay put in response to being informed that the parent is searching for the child, 53:27-54:14) where the toy figures include freely mobile characters and a portable owl doll for users to carry (49:6-15 and 49:19-28) where the mobile character transmits information identifying the character (48:66-49:5) and information is received by the other figures (50:47-49). Gabai further discloses that the figures have the ability to direct users to facilities in the theme park (56:34-39 and 56:65-57:9) as well as to direct them to the location of other users in the park (53:27-54:14). Gabai lacks in explicitly stating that the portable toy would be able to notify the user that a mobile character is nearby.

17. In related prior art, Rose discloses a device responsive to receipt of a signal transmitted by another to automatically notify the user via the device that a character is nearby (2:16-40). One skilled in the art would recognize the stated advantages of a doll with responsive speech to provide inspiration for a child's imagination and to maintain the child's interest in said doll (1:59-2:15).

18. Therefore it would have been obvious to one skilled in the art at the time of the invention to have modified Gabai in view of Rose to have included a response to the signal of a nearby character in order to stimulate the child's imagination and maintain the child's interest in the doll.

19. In regards to claims 10 and 11, Gabai discloses the use of infrared or radio frequency signals (51:15-24).

20. In regards to claims 25-27, Gabai discloses that the toys may produce sound effects, music and speech (7:12-19 and 7:31-34).

21. Claims 19-24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabai et al. (US 6352478).

22. In regards to claim 19, Gabai discloses a figure with wireless communication equipment (48:30-37) that receives information from a plurality of wireless transmitters in a surrounding environment that generate signals representing the location of objects and characters in the environment (48:66-49:5), memory (figures 71 and 74, element 4030 and 4270 respectively, which are related to figure 6 with description 35:31-32) preprogrammed with data related to location (56:34-39 and 56:65-57:9). Gabai further discloses the storage of data related to the events of a user in the park (51:63-52:25). Gabai further discloses the communicating with the user based on the user's event data (figures 52-57). Gabai does not explicitly disclose that the memory is located within the figure. However, at the time of invention it would have been an obvious matter of design choice where to locate the memory within the system, be it within a device such as in the instant application or in a centralized location and transmitted to the device as in the system of Gabi. Each system produces the expected results of providing data to the interactive toy.

23. In regards to claim 20, the user's name is stored in memory (52:37-41).

24. In regards to claim 21, the toy addresses the user using the name from memory (figure 46A, element 2810).

25. In regards to claims 22 and 23, Gabai discloses the use of infrared or radio frequency signals (51:15-24).

26. In regards to claim 24, each object, location or character corresponds with a wireless signal transmitter (49:16-18).

27. In regards to claim 28, Gabai discloses a method of conveying location of a toy character in an environment to a user carrying the toy character by providing in the environment one or more signal transmitters configured to transmit signals indicating location information (48:30-37 and 48:66-49:5); providing a toy character to the user where each toy has a signal receiver to receive the signal (fig 36 element 2180) a programmable memory configured to store software and preprogrammed data (figures 71 and 74, element 4030 and 4270 respectively, which are related to figure 6 with description 35:31-32) a processor that utilizes the software to interpret the signals and trigger playback of a data related to the signals received associated with a location within the environment (56:34-39 and 56:65-57:9); and distributing one or more characters to the persons in the persons within the environment (fig 81, element 5000). Gabai does not explicitly disclose that the memory is located within the character. However, at the time of invention it would have been an obvious matter of design choice where to locate the memory within the system, be it within a character such as in the instant application or in a centralized location and transmitted to the device as in the system of Gabi. Each system produces the expected results of providing data to the interactive toy.



***Response to Arguments***

28. Applicant's arguments filed 11/12/2008 have been fully considered but they are not persuasive.

29. Applicant argues that Gabai does not trigger an output in response to a received signal. Examiner respectfully disagrees. The entire substance of Gabai is directed to an entertainment system that uses wireless signals to determine proximity and location of users and entertainment devices within a park in order to provide triggered audio relevant to the location or nearby entertainment devices. That Gabai triggers the signal and sends the response from central memory to the local device instead of sending the trigger signal to the device to generate the signal is a matter of obvious design choice. One of ordinary skill in the art would have readily recognized the comparative advantages and disadvantages of a centralized system versus a decentralized system in terms of cost and infrastructure. Choosing one option over the other does not distinguish one system over the other. The location of memory within an electronic system such as Gabai does not produce unexpected results or require abilities beyond that of one of ordinary skill in the art to implement however desired. Furthermore, the broadest reasonable interpretation of a trigger signal is any signal which triggers something else. As the control signal of Gabai triggers the device to provide audio output, it would reasonably be considered a trigger signal.

30. Applicant argues that the references do not disclose preprogrammed communications. Examiner disagrees. Rose expressly discloses that the memory and data are preprogrammed in the toy device (3:53-4:8).

31. Applicant argues that the references do not disclose or teach "automatically notifying the user via the device that a character is nearby." While the Gabai does not explicitly disclose notification of a character nearby, the system does expressly disclose that it is capable of providing location information and directions to a user based on proximity and location (53:27-54:14, 56:34-39 and 56:65-57:9). Examiner contends that the system of Gabai is already capable of providing notification as the system already discloses all of the necessary features need to implement such a feature lacking only the explicit recitation of the specific audio recording. Changing the recording data to provide the desired audio notification would be well within the abilities of one of ordinary skill in the art and would be in keeping with the goals of Gabai to provide an interactive amusement park. Placing the transmitter on a "roving character" and producing "Hello Mickey" is not patentably distinguishing over the system of Gabai informing one user with a transmitter that another user with a transmitter is nearby (fig 48). The difference in audio signals and intended use are minor design considerations. Furthermore, Rose also expressly teaches that providing signals in response to proximity to another character is well known in the art.

32. Applicant is also advised of Pelekis; Frederick (US 6380844 B2) which also expressly teaches a toy triggering preprogrammed audio signals in response to signals received in proximity to a source.

### ***Conclusion***

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID W. DUFFY whose telephone number is (571)272-1574. The examiner can normally be reached on M-F 0830-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. W. D./  
Examiner, Art Unit 3714

/Corbett Coburn/  
Primary Examiner  
AU 3714